The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON T. CASSEZZA

Appeal No. 2003-0310
Application No. 09/409,330

ON BRIEF

Before THOMAS, FLEMING, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-26, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to controlling audio volume in processor-based systems. An understanding of the invention can be derived from a reading of exemplary claims 1 and 19, which are reproduced as follows:

1. A method of controlling volume levels in a processor-based system comprising:

obtaining an indicia of the volume level of audio information received by said system;

comparing the indicia to a preset level; and

automatically adjusting the volume level towards said preset level.

19. A processor-based system comprising:

a processor;

a storage coupled to said processor;

a sound generating circuit coupled to said processor; and

software stored on said storage to control the sound generated by said circuit in accordance with a pre-set volume limit.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lee	5,191,620	Mar. 2, 1993
Fado et al. (Fado)	6,067,084	May 23, 2000 (filed Oct. 29, 1997)

Claims 1-20, 23, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lee.

Claims 21, 22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Fado.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed August 12, 2002) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 9, filed May 30, 2002) and reply brief (Paper No. 11, filed September 3, 2002) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse, for the reasons set forth by appellant. We begin with the

rejection of claims 1-20, 23, 25, and 26 under 35 U.S.C. § 102(b). We turn first to claim 1.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The examiner's position is set forth on pages 3-5 of the answer. Appellant asserts (brief, page 6) that Lee merely takes user commands and converts them to increase or decrease audio volume from an undeterminable volume level, and that Lee never obtains an indicia of what the volume level was of the audio information received by the system. The examiner responds (answer, page 6) that Lee obtains an indicia of the received volume level with step 11, at figure 2, and column 2, lines 35-37, where the obtained indicia is the key-input signal, or level value.

From our review of Lee, we find that Lee discloses (col. 2, lines 31-36) that

> Referring now to FIG. 2, an input discrimination routine 100 includes a key-check step 10 for checking either existence or nonexistence of the transmitted key-input signal from the transmitter 1 or the key matrix 2 and an input-discrimination step 11 for discriminating whether the key-input signal is an up-signal or a down-signal.

From the disclosure of Lee that the key-check step checks the existence or non existence of the transmitted key-input signal, we find that Lee does not disclose obtaining an indicia of the volume of the input signal. The determination of the existence or non-existence of a signal is not a disclosure of a determination of the volume level of the signal. Although Lee discloses (col. 3, lines 60-62) "providing a pulse width modulated signal having six bits corresponding to a range of 2^n volume levels" we find no disclosure in Lee that the volume level of the signal received by the system is determined. Because Lee only checks for the existence of the signal, Lee does not disclose any determination of an indicia of the volume level of the received signal. Nor do we find any disclosure that the determination of whether the signal is an up-signal or a down-signal, represents a determination of an indicia of the volume level of an audio signal. The fact that a determination of whether a received signal is an up-signal or a down-signal is not a teaching of determining an indicia of the volume level of the received signal. As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Because Lee does not disclose obtaining an indicia of the volume level of the signal received by the system, we find that the examiner has failed to establish inherency of this feature, or a prima facie case of anticipation of claim 1.

Accordingly, the rejection of claim 1, and claims 2-9 dependent therefrom, under 35 U.S.C. § 102(b) is reversed. As independent claim 10 also requires obtaining "indicia of the volume level of audio information received by said system" the rejection of independent claim 10, and claims 11-18 dependent therefrom, is reversed.

We turn next to independent claim 19. The examiner's position (answer, page 5), inter alia, is that Lee discloses "software to control the generated sound in accordance with a preset volume limit, with the input discrimination routine 100, at figure 2." Appellant asserts (reply brief, page 2) that:

> The Examiner contends, with respect to claim 19, that Lee has software that controls the sound generated by a circuit in accordance with a preset volume limit. But, clearly, this cannot be so. Lee never knows what the volume is of the sound because Lee never knows what the volume is as received. All Lee can do is control how much the volume can be moved up or how much the volume can be moved down, but Lee has no idea of what the actual volume is. Therefore, Lee cannot control the volume in accordance with "a preset volume limit."

From our review of Lee, we agree with appellant that Lee does not disclose "software that controls the sound generated by a circuit in accordance with a preset volume limit." As shown in figure 2 and col. 2, lines 31-36) input discrimination routine includes checking for the existence or non-existence of the input signal (step 10) and for discriminating whether the input signal is an up-signal or a down signal (step 11). From the disclosure of Lee, we fail to find a disclosure of controlling the volume within preset volume limits, because Lee does not know what the volume level of the received signal is. As Lee does not determine the volume level of the received signal, we agree with appellant (brief, page 8) that:

> If the incoming volume level is relatively high, the maximum may be relatively high. If the incoming volume is relatively low, then the maximum value is lower than the maximum achieved with a lower original volume setting for the received signal. There is absolutely no indication at lines 35-37, or anywhere else in Lee, that Lee obtains any information about the real volume level of the incoming audio signal. Instead, it is

> apparent that all Lee does is receive commands from the user and responds appropriately to increase or decrease whatever volume level is received. This explanation is further supported in column 3 of Lee. There it is explained that if an up-signal is received continuously, the bar graph is continuously incremented. But if the value of the level becomes a maximum by continuous inputs of the up-key, the maximum discrimination step stops the incrementing of the PWM output and the level is fixed to the 64 level. See column 3, lines 13-16. The 64 level is clearly the amount of up-signals that can be received. In other words, up to 64 levels or steps may be received, because the display only displays so many bar graph symbols for the maximum level. The maximum level though is the maximum level for a given input signal volume, not necessarily the maximum for the system. For example, it is explained that 32 bars on the bar graph is the maximum up-signal. But the 32 bars are 32 increments of up-signal. The final volume depends on what was the volume level of the input signal. Thus, there is no indication that Lee ever controls the absolute volume of the signal. Instead, all Lee does is control the maximum amount that the signal can be increased or decreased.

Accordingly, the rejection of independent claim 19, and claims 20, 23, 25, and 26, dependent therefrom, under 35 U.S.C. § 102(b) is reversed.

We turn next to the rejection of claims 21, 22 and 24 under 35 U.S.C. § 103(a). We do not sustain the rejection of claims 21, 22, and 24 because the examiner has not shown how Fado makes up for the basic deficiencies of Lee with respect to the claims from which claims 21, 22, and 24 depend.

Accordingly, the rejection of claims 21, 22, and 24 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-20 23, 25, and 26 under 35 U.S.C. § 102(b) is reversed. The decision of the examiner to reject claims 21, 22, and 24 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge)

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Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

STUART S. LEVY
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